

REMARKS

The present application includes pending claims 1-4, 6 and 7, all of which have been rejected.

Claims 1-4, 6 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 28-44 of copending application 10/520,912. However, the Office Action does not show or explain how the claims of the present application are patentably indistinct from claims 1-11 and 28-44 of copending application 10/520,912. Instead, the Office Action merely summarily concludes that the claims of the present application and claims 1-11 and 28-44 of copending application 10/520,912 “are not patentably distinct from each other.” *See* August 5, 2008 Office Action at page 2. The Office Action even notes that claim 1 of the present application is a “method claim” (*see id.* at page 7), yet states that claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting “because the claims hold the same **structure** as the claimed invention in different embodiments” (*see id.* at page 2). Thus, for at least these reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of double patenting with respect to the claims of the present application.

Claims 1-4, 6 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-57 of copending application 10/504,474. However, the Office Action does not show or explain how the claims of the present application are patentably indistinct from claims 41-57 of copending application 10/504,474. Instead, the Office Action merely summarily concludes that the claims of the present application and claims 41-57 of copending application 10/504,474 “are not patentably distinct from each

other.” *See* August 5, 2008 Office Action at page 2. The Office Action even notes that claim 1 of the present application is a “method claim” (*see id.* at page 7), yet states that claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting “because the claims hold the same **structure** as the claimed invention in different embodiments” (*see id.* at page 2). Thus, for at least these reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of double patenting with respect to the claims of the present application.

Claims 1-4, 6 and 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-51 of U.S. 7,331,654. However, the Office Action does not show or explain how the claims of the present application are patentably indistinct from claims 34-51 of U.S. 7,331,654. The Applicants note that U.S. 7,331,654 **does not even include claims 34-51**. Nevertheless, the Office Action summarily concludes that the claims of the present application and claims 34-51 of U.S. 7,331,654 “are not patentably distinct from each other.” *See* August 5, 2008 Office Action at pages 2-3. The Office Action even notes that claim 1 of the present application is a “method claim” (*see id.* at page 7), yet states that claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting “because the claims hold the same **structure** as the claimed invention in different embodiments” (*see id.* at page 2). Thus, for at least these reasons, the Applicants respectfully submit that the Office Action has not established a *prima facie* case of double patenting with respect to the claims of the present application.

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. 112, second paragraph. The Office Action states that “the method claims focus on an apparatus.... The examiner holds weight only

Application No. 10/550,807
Attorney Docket No. 16970US01
October 27, 2008

to the method steps.” *See* August 5, 2008 Office Action. The Applicants note, however, the following:

A fundamental principle contained in 35 U.S.C. 112, second paragraph, is that applicants are their own lexicographers. They can define in the claims what they regard as their invention **essentially in whatever terms they choose** so long as any special meaning assigned to a term is clearly set forth in the specification.... Applicant may use **functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought**. As noted by the court in *In re Swineheart*, ... a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

See MPEP at 2173.01 (emphasis added). In view of the above, the Applicants respectfully request reconsideration of this claim rejection. The Applicants also note that the Office Action has not cited any authority for the proposition that a “method claim focus[ing] on an apparatus” is indefinite. If this rejection is maintained, the Applicants respectfully request a citation from the MPEP and/or other legal authority to support the rejection.

Claim 1 stands rejected under 35 U.S.C. 102(a) as being anticipated by U.S. 7,331,654 (the “‘654 patent”). 35 U.S.C. 102(a) states the following:

A person shall be entitled to a patent unless –

(a) the invention was known or used by **others in this country**, or patented or described in a **printed publication** in this or a foreign country, **before the invention thereof by the applicant for a patent**.

The present application is based on a PCT application filed March 25, 2004, and claims priority to a British application filed March 25, 2003. The ‘654 patent, on the other hand was first published as U.S. 2005/0103902 on May 19, 2005, over one year after the filing date of the PCT

application from which the present application is based. Thus, the ‘654 patent clearly is not a printed publication that antedates the filing and priority dates of the present application. Moreover, WO03/033951 was published on April 24, 2003, which still does not antedate the March 25, 2003 priority date of the present application.

Additionally,

The term “others” in 35 U.S.C. 102(a) refers to any entity which is different from the inventive entity. The entity need only differ by one person to be “by others.”

See MPEP 2132(III). The inventors for the present application and the ‘654 patent are shown below:

The Present Application	The ‘654 Patent
David Andrew Horsnell	David Andrew Horsnell
Matthew Brian Tomlin	Matthew Brian Tomlin
Ammar Lecheheb	Ammar Lecheheb
Oliver John Prime	Oliver John Prime
Michael James Fox	Michael James Fox
Christopher Michael Bates	Christopher Michael Bates

As shown above, the inventors of the present application are the exact same as those of the ‘654 patent. Because the inventors are the same and the ‘654 patent is not a printed publication that antedates the filing and priority dates of the present application, the ‘654 patent does not qualify as prior art under 35 U.S.C. 102(a) with respect to the present application.

Claim 1 of the present application also stands rejected under 35 U.S.C. 102(a) as being anticipated by U.S. 2006/0098060 (the “‘060 application”). The ‘060 application was published on May 11, 2006, well after the filing date of the PCT application from which the present application is based. Thus, the ‘060 application clearly is not a printed publication that antedates the filing and priority dates of the present application.

Additionally, the inventors for the present application and the ‘060 application are shown below:

The Present Application	The ‘060 Application
David Andrew Horsnell	David Andrew Horsnell
Matthew Brian Tomlin	Matthew Brian Tomlin
Ammar Lecheheb	Ammar Lecheheb
Oliver John Prime	Oliver John Prime
Michael James Fox	Michael James Fox
Christopher Michael Bates	Christopher Michael Bates

As shown above, the inventors of the present application are the exact same as those of the ‘060 application. Because the inventors are the same and the ‘060 application is not a printed publication that antedates the filing and priority dates of the present application, the ‘060 application does not qualify as prior art under 35 U.S.C. 102(a) with respect to the present application.

Claim 1 also stands rejected under 35 U.S.C. 102(a) as being anticipated by U.S. 2005/0231553 (the “‘553 application”). The ‘553 application was published on October 25, 2005, well after the filing date of the PCT application from which the present application is based. Thus, the ‘553 application clearly is not a printed publication that antedates the filing and priority dates of the present application.

Additionally, the inventors for the present application and the ‘553 application are shown below:

The Present Application	The ‘553 Application
David Andrew Horsnell	David Andrew Horsnell
Matthew Brian Tomlin	Matthew Brian Tomlin
Ammar Lecheheb	Ammar Lecheheb
Oliver John Prime	Oliver John Prime
Michael James Fox	Michael James Fox
Christopher Michael Bates	Christopher Michael Bates

As shown above, the inventors of the present application are the exact same as those of the '553 application. Because the inventors are the same and the '553 application is not a printed publication that antedates the filing and priority dates of the present application, the '553 application does not qualify as prior art under 35 U.S.C. 102(a) with respect to the present application.

Claim 1 also stands rejected under 35 U.S.C. 102(a) as being anticipated by EP 0109242 ("Taylor"). "A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The **identical** invention must be shown in as complete detail as is contained in ... the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). The Office Action has not shown that Taylor describes, teaches or suggests all the limitations of claim 1. That is, the Office Action has not shown that Taylor describes, teaches or suggests "each and every element as set forth in the claim" or that it describes an embodiment "in as complete detail as is contained" in claim 1. Indeed, the Office Action fails to address numerous limitations of claim 1 of the present application. Thus, the Office Action has not established a *prima facie* case of anticipation with respect to claim 1.

The Office Action asserts that "[i]t is noted that the rest of the limitations [that the Office Action fails to address] are part of an apparatus, which is not given weight in a method claim." *See* August 5, 2008 Office Action at page 7. Again, however, the Office Action cites no authority for this assertion. If this rejection is maintained, the Applicants respectfully request a citation from the MPEP and/or other legal authority that supports such an assertion.

Application No. 10/550,807
Attorney Docket No. 16970US01
October 27, 2008

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: October 27, 2008

/Joseph M. Butscher/

Joseph M. Butscher

Registration No. 48,326

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

Telephone: (312) 775-8000

Facsimile: (312)775-8100